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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/010,801	01/22/1998	MARK HAMBURG	07844/235001	9111

21876 7590 09/12/2003

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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/010,801

Applicant(s)

HAMBURG ET AL.

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-25,27-37 and 39-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-25,27-37 and 39-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-7, 9-25, 27-37, and 39-47 are pending in this communication.
2. Applicants' finality of the rejection of the last Office action is hereby withdrawn in view of the new grounds of rejection here below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1, 16, 22, 37, 40, 45- 47 are rejected under 35 U.S.C. 102(a) as being anticipated by (US 5,828,375) Nomura et al.

With respect to claims 1, 16, 37, 40, and 45-47, Nomura teaches, maintaining in a memory a state history of a document (col. 3, lines 53-65); and whenever an interesting operation has occurred, an interesting operation being an operation by a user that changes the state of the document, automatically capturing the state of the document as it exists after operation and adding the captured state to the state history (col. 39, lines 9-19, col. 41, lines 27-39 and lines 49-57, and fig. 57).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 2-7 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,828,375) Nomura et al, hereafter Nomura in view of (US 6,310,630) Kulkarni et al, hereafter Kulkarni.

With respect to claim 2, Nomura did not teach, wherein the memory comprises a disk file.

Kulkarni discloses, wherein the memory comprises a disk file (col. 4, lines 55-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the memory comprise a disk file and to modify in Nomura because such a modification would allow Nomura to have a removable memory which may include a floppy disk or hard disk.

With respect to claim 3, Nomura teaches, maintaining in the state history the order in which the stored states were automatically added to the state history (col. 17, lines 37-42 and col. 18, lines 6-14 and lines 56-64), displaying the state history to a user as a list of document states shown in their stored order (col. 17, lines 34-47).

With respect to claim 4, Nomura teaches, the list of document states displayed to the user comprises a list of items, each item representing a state of the document that existed after an interesting operation and that can be recovered directly by selecting the item (col. 21, lines 15-36 and fig. 18).

With respect to claim 5, Nomura teaches, providing a tool operable under user control to obtain source material from any state in the state history ("... a pointing device and actuating the pointing device.") and apply it to a current state of the document, where the document is a raster image (col. 21, line 47-67).

With respect to claim 6, Nomura teaches, enabling a user to select an item in the displayed list of items and cause the application to create a new document having the document state corresponding to the selected item (col. 21, lines 5-46).

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With respect to claim 7, Nomura teaches, each of the captured states in the state history maintains the state data in essentially its original form, whereby the captured state data is suitable for immediate use in other operations (col. 33, lines 58-67, col. 34, lines 1-65, and col. 22, lines 21-29).

With respect to claim 22, Nomura teaches, identifying for the user on a display device a set of states that the document has been in by operation of the application (col. 13, lines 53-67 and col. 14, lines 1-6) and enabling the user to designate any one of the identified states as a document state operand (col. 15, lines 31-43).

With respect to claim 23, Nomura teaches, displaying the document in a user interface window, the document being a digital image (col. 12, lines 3-33)

With respect to claim 24, Nomura teaches, displaying user-interface elements for applying filters to a digital image (col. 4, lines 41-51, col. 14, lines 50-60, col. 20, lines 61-67, and col. 21, lines 1-4).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9-15, 17-21, 39, 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,828,375) Nomura et al in view of (US 5,659,747) Nakajima and further in view of (US 6,310,630) Kulkarni et al, hereafter Kulkarni.

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With respect to claims 9 and 39, Nomura teaches, receiving from the user a sequence of commands to change the document (col. 35, lines 31-41), changing the document state in response to each command (col. 36, lines 5-12), adding the changed document state to a state history maintained in a computer-readable memory device each time the document state is changed (col. 17, lines 37-42 and col. 18, lines 6-64) and in response to a user action, selecting an item in the history list and establishing the document state corresponding to the selected item in the history list as the current state of the document (col. 14, lines 50-61 and col. 16, lines 37-47).

Nomura did not teach, for each document state added to the state history, adding a corresponding entry to a history list displayed to the user on a computer-controlled display device operated as part of a graphical user interface.

Nakajima discloses, for each document state added to the state history, adding a corresponding entry to a history list displayed to the user on a computer-controlled display device operated as part of a graphical user interface (col. 3, lines 25-31 and lines 60-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made for each document state added to the state history, adding a corresponding entry to a history list displayed to the user on a computer-controlled display device operated as part of a graphical user interface and to modify in Nomura because such a modification will allow changes to be made to a document and to have programs, files, and options by means of icons, menus, and dialog boxes on the screen. The user can select and activate these options by pointing and clicking with a mouse or with the keyboard.

With respect to claim 10, Nomura teaches, the state history and the history list are limited to storing a preset number of items and excess items are scrolled off the top of the list as new items are added (col. 5, lines 1-18 and lines 60-66).

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With respect to claim 11, Nomura and Nakajima did not teach, the state history is stored in a region of memory and the oldest document states in the state history are discarded when free space in the region runs low.

Kulkarni discloses, the state history is stored in a region of memory and the oldest document states in the state history are discarded when free space in the region runs low (col. 5, lines 49-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the state history is stored in a region of memory and the oldest document states in the state history are discarded when free space in the region runs low and to modify in Nomura and Nakajima because such a modification would allow Nomura and Nakajima to have a memory space location within random access memory where the history can be added or deleted (discarded).

With respect to claim 12, Nomura and Nakajima did not teach, the oldest document states are found and discarded by a memory management process.

Kulkarni discloses, the oldest document states are found and discarded by a memory management process (col. 7, lines 28-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the oldest document states are found and discarded by a memory management process and to modify in Nomura and Nakajima because such a modification would allow Nomura and Nakajima to have the entire contents of each page contained in the history and the history can be written to a file which is stored on a disk and since a limited amount of memory for data storage and the oldest data will usually be deleted (discarded).

With respect to claim 13, Nomura teaches, in response to a user a command to change the document state corresponding to the selected item in the history list and established as the current state of the document, deleting items after the selected item

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in the history list and the corresponding document states from the state history (col. 14, lines 50-51, col. 16, lines 37-47, and col. 22, lines 60-65).

With respect to claim 14, this dependent claim is rejected for the similar rationale given above for claims 9-13.

With respect to claim 15, Nomura and Nakajima did not teach, enabling a user interface gesture on the history list to create a new document from a document state from the state history.

Kulkarni discloses, enabling a user interface gesture on the history list to create a new document from a document state from the state history (col. 7, lines 46-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have a user interface gesture and to modify in Nomura and Nakajima because such a modification would allow the user to select an icon and to perform an operation on the list to create a document.

With respect to claims 17, 18, 41, and 42 Nomura and Nakajima did not teach, keeping a history of document states of a document (col. 4, lines 32-52), the document states being created automatically whenever a user command to the application changes the state of the document and being complete in themselves.

Nomura and Kulkarni did not teach, enabling the user to step backward and forward through the revised history and thereby alter the state of the document to be any of the document states in the revised history.

Kulkarni discloses, keeping a history of document states of a document, the document states being created automatically whenever a user command to the application changes the state of the document and being complete in themselves (col. 7, lines 20-28).

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Nakajima discloses, enabling the user to step backward and forward through the revised history and thereby alter the state of the document to be any of the document states in the revised history (col.5, lines 58-67 and col. 6, lines 1-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to enable the user to discard any of the history and to modify in Nomura and Kulkarni because such a modification in Nomura and Kulkarni would allow the history list of a document and the commands performed to be updated frequently by a user.

With respect to claim 19, Nomura and Nakajima did not teach, saving the history when the document is closed on a long-term storage medium, whereby the history may be restored when the document is later opened and across invocations of the application.

Kulkarni discloses, saving the history when the document is closed on a long-term storage medium, whereby the history may be restored when the document is later opened and across invocations of the application (col. 8, lines 5-18). It would have been obvious to one having ordinary skill in the art at the time the invention was made to save the history when the document is closed on a long-term storage medium, whereby the history may be restored when the document is later opened and across invocations of the application and to modify in Nomura and Nakajima because such a modification would allow Nomura and Nakajima to determine whether the history is saved from a previous browsing session and if not, user options are entered which include a long-term storage medium.

With respect to claim 20, Nomura and Nakajima did not teach, the saved history resides in the document with final document data.

Kulkarni discloses, the saved history resides in the document with final document data (col. 6, lines 13-23). It would have been obvious to one having ordinary skill in the

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art at the time the invention was made to have the history reside with the final document data and to modify in Nomura and Nakajima because such a modification would allow the previously generated data to be represented to the user and associated with the stored (saved) data.

With respect to claim 21, Nomura and Nakajima did not teach, the saved history resides in a long-term data repository independent of the original document.

Kulkarni teaches, the saved history resides in a long-term data repository independent of the original document (col. 6, lines 14-23 and fig. 3 (313 & 312)).

With respect to claim 25, this dependent claim is rejected for the similar rationale given above for claim 13.

With respect to claim 27, Nomura teaches, providing the user a delete tool for deleting the designated state from the set of states (col. 6, lines 18-36).

With respect to claim 28, Nomura teaches, the set of states is identified by displaying a scrollable list of elements (col. 15, lines 33-47).

With respect to claim 29, Nomura teaches, the list of elements are ordered by the time the corresponding states were created (col. 16, lines 26-47).

With respect to claim 30, this dependent claim is rejected for the similar rationale as given above for claims 13 and 25.

With respect to claim 31, Nomura and Nakajima did not teach, enabling the user to make a gesture on a user interface indicating a sequence of displayed state identifiers and responding to the gesture by displaying the document in the states indicated as the gesture is made.

Kulkarni discloses, enabling the user to make a gesture on a user interface indicating a sequence of displayed state identifiers and responding to the gesture by displaying the document in the states indicated as the gesture is made (col. 7, lines 46-

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65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to enable a user to make a gesture on a user interface indicating a sequence of displayed state identifiers and responding to the gesture by displaying the document in the states indicated as the gesture is made and to modify in Nomura and Nakajima because such a modification would allow Nomura and Nakajima to display a browsing session and to selected an option when the session was last created or modified.

With respect to claim 32, Nomura and Nakajima did not teach, enabling the user to modify the document state after the establishing step and adding the document state resulting from the modification to the set of states identified on the display device. Kulkarni discloses, enabling the user to modify the document state after the establishing step and adding the document state resulting from the modification to the set of states identified on the display device (6, lines 45-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have an installing step and to modify in Nomura and Nakajima because such a modification would allow the user to create a state for each command in the system and the document to be displayed for the modification of the document.

With respect to claim 33, Nomura and Nakajima did not teach, the set of states is displayed in order of creation of the states in the set.

Kulkarni discloses, the set of states is displayed in order of creation of the states in the set (col. 6, lines 1-11 and lines 24-44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the set of states is displayed in order of creation of the states in the set and to modify in Nomura and Nakajima because such a modification would allow Nomura and Nakajima to have a step for adding a new data record and to have the history to contain a new data record

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(order of creation) associated with a list of the web pages in an entry that might contain a pointer to the file.

With respect to claim 43, this independent claim is rejected for the similar rationale given for claims 32 and 33.

9. Claims 34-36 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomura, Nakajima, and Kulkarni in view of Kurlander, David and Feiner, Steven, hereafter Kurlander and Feiner.

With respect to claim 34, Nomura, Nakajima, and Kulkarni did not teach, the document is a digital image.

Kurlander and Feiner discloses, the document is a digital image (page 127, col. 2, lines 19-24). It would have been obvious to one having ordinary skill in the art of documents at the time the invention was made to have the document as a digital image and to modify in Nomura, Nakajima, and Kulkarni because such a modification in Nomura, Nakajima, and Kulkarni would allow the image being displayed to represent any kind of a document such as a scanned picture in a bitmapped format or any other type of document that may be represented on a computer screen.

With respect to claim 35, Nomura, Nakajima, and Kulkarni did not teach, providing a step backward and a step forward command for the user to execute to navigate the set of states and providing a separate undo and redo command for the user to undo and redo commands.

Kurlander and Feiner discloses, providing a step backward and a step forward command for the user to execute to navigate the set of states and providing a separate undo and redo command for the user to undo and redo commands (page 127, col. 2, paragraph 1, lines 12-15 and page 128, col. 1, paragraph 3, lines 11-18). It would have

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been obvious to a one having ordinary skill in the art at the time the invention was made to provide a step backward and a step forward command for the user to execute to navigate the set of states and provide separate undo and redo commands and to modify in Nomura, Nakajima, and Kulkarni because such a modification would enable the user to toggles between the two states of a document and to make a comparison of a result of the command.

With respect to claim 36, this dependent claim is rejected for the similar rationale as given for claim 35.

With respect to claim 44, this dependent claim is rejected for the similar rationale given above for claims 35 and 36.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Baker et al (US 6,185,591) disclosed a text editing system with an undo interface.

Dickman et al (US 5,877,765) disclosed internet desktop shortcut icons.

Inquiries


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for

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the organization where this application or proceeding is assigned is (703) 305-7687
(Official Fax) and (703) 746-5622 (Unofficial Fax).

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the receptionist whose telephone number is 703-308-
1113.


E. Colbert
September 8, 2003